



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,584	05/16/2001	Thomas M. Collins	2280.2700	1405
26211	7590	06/21/2005	EXAMINER	
FISH & RICHARDSON P.C. CITIGROUP CENTER 52ND FLOOR 153 EAST 53RD STREET NEW YORK, NY 10022-4611			BATURAY, ALICIA	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,584

Applicant(s)

COLLINS ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/19/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

AD

DETAILED ACTION

1. This Office Action is in response to the amendment filed 31 March 2005.
2. Claims 1-29 were amended.
3. Claims 30-39 were added.
4. Claims 1-39 are pending in this Office Action.

Response to Amendment

5. The objection to the specification regarding the use of trademarks and minor informalities was addressed and is withdrawn.
6. The rejection of claims 1-11 under 35 U.S.C. 101 regarding reciting non-statutory subject matter was addressed and is withdrawn. However, the amendments presented necessitated new grounds of 35 U.S.C. 101 rejections, which are outlined below.
7. Applicant's amendments and arguments with respect to claims 1-29 and new claims 30-39 filed on 31 March 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the use of the term "machine-readable medium" appears in the amended claims, but is not disclosed or defined in the specification.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention lacks antecedent basis in the specification for the phrase "a machine-readable medium storing machine-readable instructions." However, it is noted that because the specification is drawn to storing the computer instructions on hardware, this limits the invention to a tangible medium.

11. Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention recites "...the apparatus being operable to allow a user of the apparatus to..." which is not substantially equivalent to the program being executed by a computer to cause the computer to perform the recited steps. Applicant's use of the phrase "being operable" raises a question as to what the claim actually requires. It is unclear whether or not this program explicitly causes the computer to perform the steps in the claim.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-5, 7-16, 18-22, 24-28, 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler (U.S. 6,192,396) and further in view of Beck et al. (U.S. 5,903,723).

14. As to claim 1, Kohler discloses an article comprising a machine-readable medium storing machine-readable instructions that, when applied to the machine, cause the machine to: enable a sender to input a message (Kohler, Fig. 6, element 51); enable the sender to append an attachment to the message (Kohler, Fig. 6, element 46); enable the sender to designate at least one recipient of the plurality of recipients to receive the message and the attachment; enable the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Kohler, col. 2, lines 14-21) and transmit the message over a network (Kohler, col. 3, lines 51-53) to the plurality of recipients (Kohler, col. 2, lines 14-21). But Kohler does not expressly disclose the transmission of a message using less bandwidth than that of a message and attachment. However, Beck does teach the transmission to the at least one recipient of the plurality of recipients to receive the message without the attachment uses less bandwidth of the network than the transmission to the at least one recipient of the plurality recipients to receive the message with the attachment (Beck, col. 1, lines 36-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kohler and Beck in order to allow transmission of e-mail attachments from a sender of a network to at least one recipient of the network (Beck, col. 1, lines 62-64).

15. As to claims 2, 8, 13, 19, and 25, the combination of Kohler and Beck (Kohler-Beck) discloses the invention substantially including discloses the invention substantially including instructions that, when applied to the machine, cause the machine to send the message from a first computer to a second computer over the network (Kohler, col. 3, lines 51-53).
16. As to claims 3, 9, 14, 20, and 26, Kohler-Beck discloses the invention substantially including instructions that, when applied to the machine, cause the machine to send the message from the first computer to the second computer over an Internet network (Kohler, col. 3, line 57-60).
17. As to claim 4, 10, 15, 21 and 27, Kohler-Beck discloses the invention substantially including instructions that, when applied to the machine, cause the machine to send the message from the first computer to the second computer over a local area network (LAN) (Kohler, col. 3, line 57).
18. As to claims 5, 11, 16, 22, and 28, Kohler-Beck discloses the invention substantially including instructions that, when applied to the machine, cause the machine to send the message from the first computer to the second computer over a wide area network (WAN) (Kohler, col. 3, line 57-58).
19. As to claim 7, Kohler-Beck discloses the invention substantially including an article comprising a machine-readable medium storing machine-readable instructions that, when

applied to the machine, cause the machine to: allow a sender to designate a plurality of recipients of electronic mail; transmit the electronic mail over a network to the plurality of recipients; associate each of the plurality of recipients with one of the following categories (Kohler, col. 7, lines 17-19): a first category to indicate the recipient of the electronic mail is to receive both a text message and an attached file, a second category to indicate the recipient of the electronic mail is to receive both a text message and an attached file; a third category to indicate that the recipient of the electronic mail is to receive a text message without the attached file (Kohler, col. 7, lines 30-40; Fig. 6, element 63), where transmission to the tertiary recipient of the electronic mail uses less bandwidth of the network than the transmission to either the primary recipient or the secondary recipient (Beck, col. 1, lines 62-64).

20. As to claim 12, claim 1 is a method performing the same functions as claim 12. Therefore, paragraph 14 of this Office Action discloses all of the limitations of claim 12.
21. As to claim 18, claim 1 performs the same functions as claim 18. Therefore, paragraph 14 of this Office Action discloses all of the limitations of claim 18.
22. As to claim 24, claim 1 is a method performing the same functions as claim 24. Therefore, paragraph 14 of this Office Action discloses all of the limitations of claim 24.

23. As to claims 30, 32, 34, 36 and 38, Kohler-Beck discloses the invention substantially including instructions that, when applied to the machine, cause the machine to incorporate an icon in the message without the attachment, the icon indicative of the attachment sent to the at least one recipient to receive the message with the attachment (Kohler, col. 11, lines 62-65).
24. As to claims 31, 33, 35, 37 and 39, Kohler-Beck discloses the invention substantially including instructions that, when applied to the machine, cause the machine to name the icon the same name as the attachment sent to the at least one recipient to receive the message with the attachment (Kohler, col. 11, lines 62-65).
25. Claims 6, 17, 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler-Beck, and further in view of Thurlow, et al (U.S. 5,917,489).

As to claims 6, 17, 23 and 29, Kohler-Beck discloses the invention substantially but do not explicitly teach recipient creation of a profile. However, Thurlow teaches a similar system for sending email that includes user profiles (Thurlow, col. 7, lines 54-58) Including instructions that, when applied to the machine, cause the machine to enable the recipient to create and edit a recipient profile, the profile including the recipient's preferences with regard to receipt of current and prospective attachments (Thurlow, col. 10, lines 55-67; col. 11, Table 1). It would have been obvious to combine the teachings of Kohler and Thurlow to

allow for an improved method of creating and editing rules for processing electronic mail (Thurlow, col. 1, lines 55-57).

Response to Arguments


26. Applicant's arguments filed 3 November 2004 have been fully considered, but they are not persuasive for the reasons set forth below.

27. ***Applicant Argues:*** As to claims 1-5, 7-16, 18-22 and 24-28, Applicant states "The Kohler reference does not teach transmitting the message over a network using less bandwidth of the network for the message without the attachment than the message with the attachment."

In Response: Applicant's arguments with respect to claims 1-5, 7-16, 18-22 and 24-28 have been considered but are moot in view of the new ground(s) of rejection.

28. ***Applicant Argues:*** As to claims 6, 17, 23 and 29, Applicant states "There is no suggestion that the profiles disclosed in the Thurlow patent include the recipient's preferences with regard to receipt of current and prospective attachments."

In Response: The examiner respectfully submits that Thurlow teaches a user working through the process of selecting available conditions (recipient's preferences) including if the message has an attachment (see Thurlow, col. 11, Table I, last line). The conditions include a



Application/Control Number: 09/855,584

Page 9

Art Unit: 2155

field to indicate when the rule will be applied, which can be when the messages are received (receipt of prospective attachments) or on existing folders where messages are already present (receipt of current attachments – see Thurlow, col. 11, lines 19-45). This renders the rejection proper, and the rejection stands.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 09/855,584
Art Unit: 2155

Page 11

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
June 14, 2005


SALEH MAJJAR
PRIMARY EXAMINER